

Examiner Chang maintains the present obviousness-type double patenting rejection for the reasons given in section 8 of paper no. 9 (the August 30, 2002 final Office Action). Further, in support of his position, Examiner Chang notes that claims 21-30 are new claims (see the January 14, 2003 Office Action, page 2, line 13), not original claims 11-20, which were withdrawn from consideration as being directed to a patentably distinct invention.

Applicants respectfully submit that an obviousness-type double patenting rejection over claims 1-2 and 6-8 of U.S. Patent No. 6,316,099 is prohibited under 35 U.S.C. §121 for at least the reasons given in Applicants' October 30, 2002 Amendment and Response (paper no. 10), and Applicants' December 02, 2002 Request for Continued Examination (paper no. 13). As noted in papers nos. 10 and 13, the present application is a divisional patent application filed as a direct result of a restriction requirement in parent application serial number 09/409,520, which issued as U.S. Patent No. 6,316,099 (see the December 28, 1999 Restriction Requirement, paper no. 2, in USSN 09/409,520).

Original claims 11-20 of parent application serial number 09/409,520 were withdrawn from consideration as being directed to a patentably distinct invention. Claims 11-20 are now in the present application. The elected claims in USSN 09/409,520, claims 1-10, were directed to articles comprising, *inter alia*, (1) a photo-activated, epoxy-containing bulk layer having a first major surface; and (2) a photo-activated, epoxy-containing adhesive layer bonded to the first major surface of the bulk layer, wherein upon photo-activation, the bulk layer has a different curing rate than the adhesive layer. Non-elected claims 11-20 of parent application serial number 09/409,520 were directed to articles comprising, *inter alia*, (1) a conformable, compressible, melt flow-resistant foam core; (2) a photo-activated, epoxy-containing bulk layer having a first and second major surface, wherein the foam core is bonded to the second major surface of the bulk layer; and (3) an epoxy-containing adhesive layer bonded to the first major surface of the bulk layer, wherein upon photo-activation, the bulk layer has a different curing rate than the adhesive layer.

Non-elected claims 11-20 differed from elected claims 1-10 by reciting a conformable, compressible, melt flow-resistant foam core layer. The December 28, 1999 Restriction Requirement specifically states that the two inventions, namely the invention of

claims 1-10 and the invention of claims 11-20, "**are deemed patentably distinct since there is nothing on this record to show them to be obvious variants**" (emphasis added). Now, Examiner Chang maintains that claims 21-30 are obvious in view of U.S. Patent No. 6,316,099.

Applicants respectfully submit that 35 U.S.C. §121 prohibits the above obviousness-type double patenting rejection based on U.S. Patent No. 6,316,099. MPEP §804.01 specifically states that restriction requirements based on an intermediate-final product analysis, like the above-described December 28, 1999 Restriction Requirement, fall within the prohibition against a holding of double patenting (see MPEP §804.01, second paragraph). Further, the prohibition against a holding of double patenting under MPEP §804.01 applies to newly added claims, such as claims 21-30 of the present invention, as long as the newly added claims are "consonant in scope to the original claims subject to the restriction in the parent."

Claims 21-28 depend from original claim 11, and recite additional claim features. However, claims 21-28 do not alter the fact that the claimed invention contains a foam core layer (as recited in original claim 11), which is the patentably distinct claim element according to the above-described December 28, 1999 Restriction Requirement. The claimed subject matter of new claims 21-28 is clearly "consonant in scope" to original claims 11-20, which were subjected to a restriction requirement in the parent application.

Further, new claims 29-30 are also "consonant in scope" to original claims 11-20. Like original independent claim 11, new claims 29-30 are directed to articles containing, *inter alia*, (1) a conformable, compressible, melt flow-resistant foam core; (2) a photo-activated, epoxy-containing bulk layer having a first and second major surface, wherein the foam core is bonded to the second major surface of the bulk layer; and (3) an epoxy-containing adhesive layer bonded to the first major surface of the bulk layer, wherein upon photo-activation, the bulk layer has a different curing rate than the adhesive layer. Clearly, the line of demarcation between independent inventions (i.e., the invention of claims 1-10 and the patentably distinct invention of claims 11-20) has been maintained in new claims 21-30 since all of new claims 21-30 are directed to articles containing, *inter alia*, a foam core layer.

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For at least the reasons given above and in papers nos. 10 and 13, Applicants submit that the rejection of claims 21-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 6-8 of U.S. Patent No. 6,316,099 issued to George et al. in view of European Patent No. 0392090 is improper. Accordingly, withdrawal of this rejection is respectfully requested.

## II. Prior Art Rejections

### Claim Rejections Under 35 U.S.C. §103(a)

Claims 11-20 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,284,360 issued to Johnson et al. (hereinafter "Johnson") in view of Japanese Patent Application Publication No. 10195393 issued to Sekisui Chemical Company (hereinafter "Sekisui '393"). This rejection is respectfully traversed.

### Johnson Is Not Prior Art Under 35 U.S.C. §103(a) or 35 U.S.C. §102(e)

MPEP §706.02(I)(1) states

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues.

The present invention and Johnson were both owned by the 3M Company at the time the present invention was made. Further, the present application was filed after November 29, 1999 and is a continuing application filed under 37 CFR 1.53(b). ✓

For at least the reasons given above, Johnson is not prior art to the present invention under 35 U.S.C. §103(a). Accordingly, the rejection of claims 11-20 under 35 U.S.C. §103(a) as being obvious over Johnson in view of Sekisui '393 is improper. ?

Even If Johnson Is Prior Art Under 35 U.S.C. §103(a) or 35 U.S.C. §102(e), Johnson In Combination With Sekisui '393 Fails To Make Obvious Applicants' Claimed Invention

Even if Johnson is considered prior art under 35 U.S.C. §103(a), the combined teaching of Johnson and Sekisui '393 fails to make obvious Applicants' claimed invention for at least the reasons given in papers nos. 10 and 13. As discussed in papers nos. 10 and 13, (1) there is no disclosure, teaching or suggestion in Johnson, Sekisui '393, or the combined teaching of Johnson with Sekisui '393 that would motivate the person of ordinary skill in the art to substitute a multi-layered pressure-sensitive adhesive laminate, having a first pressure-sensitive adhesive layer and a second pressure-sensitive adhesive layer, for the sealant layer in the articles of Johnson; (2) there is no disclosure, teaching or suggestion in Johnson, Sekisui '393, or the combined teaching of Johnson with Sekisui '393 to replace the sealant layer in the articles of Johnson with the Sekisui '393 multi-layered pressure-sensitive adhesive laminate, where the first and second pressure-sensitive adhesive layers have different cure rates; (3) the teaching of Johnson expressly teaches away from the proposed substitution suggested by Examiner Chang.

Examiner Chang suggests that one of ordinary skill in the art would have (1) given the teaching of Johnson, realized that the sealant layer in the teaching of Johnson had one or more shortcomings, including (i) a lack of initial adhesive strength and (ii) a combination of sealant layers having different curing rates within each layer; (2) ignored the disclosure of Johnson specifically excluding pressure sensitive adhesive compositions as suitable sealant layer materials; (3) sought out the teaching of Sekisui '393 directed to sheets comprising multiple layers of pressure sensitive adhesives; and (4) replaced the sealant layer of Johnson with a sheet of pressure sensitive adhesive layers as disclosed in Sekisui '393 in order to "obtain an excellent initial adhesive strength imparted by the difference in curing rate" (see January 14, 2003 Office Action, page 3, lines 16-19). Applicants disagree.

It is not clear to Applicants why one of ordinary skill in the art, given the teaching of Johnson, would seek out the teaching of Sekisui '393. As discussed in papers nos. 10 and 13, the teaching of Johnson specifically excludes pressure sensitive adhesive compositions as suitable sealant layer materials. The need to seek out a reference such as

Sekisui '393, which is solely directed to pressure sensitive adhesive compositions, is not evident from the teaching of Johnson.

Further, it is not clear to Applicants why one of ordinary skill in the art would combine the teaching of Sekisui '393 with the teaching of Johnson. As discussed above, the teaching of Johnson does not suggest the need to have initial adhesive strength or multiple sealant layers having different curing rates therein. In fact, the teaching of Johnson teaches away from the desire to have initial adhesive strength given the exclusion of pressure sensitive adhesive compositions as suitable sealant layer components in the articles of Johnson. Accordingly, it is not clear to Applicants why one of ordinary skill in the art would combine the teaching of Sekisui '393 with the teaching of Johnson.

Applicants respectfully submit that one of ordinary skill in the art would not have combined the teaching of Sekisui '393 with the teaching of Johnson absent the impermissible use of hindsight. The only motivation for such a combination of teachings has been deemed from a review of Applicants' invention, not from what is being taught or suggested from the cited art. For at least this reason, Applicants respectfully submit that the combination of the teaching of Johnson with the teaching of Sekisui '393 is improper.

For at least the reasons given above, Applicants respectfully submit that claim 11 is patentable over the combined teaching of Johnson with Sekisui '393. Since claims 12-20 depend from independent claim 11, and recite additional claim features, Applicants respectfully submit that claims 12-20 are also patentable over the combined teaching of Johnson with Sekisui '393. Accordingly, Applicants respectfully request withdrawal of this rejection and the allowance of claims 11-20.

In the January 14, 2003 Office Action, Examiner Chang argues that the teaching of Johnson does not teach away from the use of pressure sensitive adhesives as suitable sealant layers. Examiner Chang argues

it is noted that Johnson also appear to be limiting the definition of the "pressure sensitive adhesive" to un-cured adhesives (column 2, lines 7-21), whereas Sekisui is directed to a "curable sticking sheet for jointing members (Derwent Abstract of JP 10195393), which is clearly consistent with the definition of "thermosetting sealant compositions" provided by Johnson (column 2, lines 2-6 and 22-31). As such, it would have been obvious to one of ordinary skill in the art of thermosetting sealant to substitute Johnson's adhesive layer, motivated by the desire to obtain an excellent

initial adhesive strength imparted by the difference in curing rates, as taught by Sekisui.

Applicants note that Johnson discloses a definition of pressure sensitive adhesives established by the Pressure Sensitive Tape Council (PSTC), which encompasses compositions that are "aggressively and permanently tacky at room temperature..." The teaching of Johnson specifically excludes adhesive compositions that are "aggressively and permanently tacky at room temperature" from being used as sealant layer materials. The adhesive layers disclosed in the teaching of Sekisui '393 are pressure sensitive adhesives, which are "aggressively and permanently tacky at room temperature." Applicants respectfully submit that one of ordinary skill in the art, given the teaching of Johnson, would not have sought out the teaching of Sekisui '393, and especially, would not have replaced a sealant layer in the article of Johnson with a pressure sensitive adhesive layer as taught by Sekisui '393 given the disclosure of Johnson excluded such adhesives that are "aggressively and permanently tacky at room temperature."

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air

### III. Conclusion:

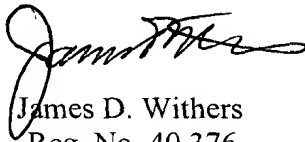
For at least the reasons given above, Applicants submit that claims 11-30 are in condition for allowance. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 10-1215.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicants' representative at the telephone number listed below.

Amendment And Response  
Serial No. 09/713,382

Respectfully submitted,  
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